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EXAMINER
HANG, P

ART UNIT	PAPER NUMBER
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/2/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11, 13-15, 17-23, 25-26 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-11, 13-15, 17-23, 25-26 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

1. Claims 1-11, 13-15, 17-23, and 25-26 are presented for examination.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The affadavit under 37 C.F.R. § 1.132 filed 5/19/93 is insufficient to overcome the rejection of claims 1-11, 13-15, 17-23, and 25-26 based upon 35 U.S.C. § 103 as set forth in the last Office action because the evidence of commercial success is not convincing.

4. Applicant alleges a commercial success of the invention and has submitted several articles alleging commercial success, applicant has not submitted sufficient evidence for a showing of commercial success of the invention claimed in the present application for patent. "Patentee which asserts commercial success to support its contention of non-obviousness bears burden of proof of establishing nexus between proven success and patented invention, and prima facie case of nexus is established by evidence of commercial success and by demonstrating that commercially successful product or method is invention disclosed and claim[ed] in patent" Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 7 U.S.P.Q.2d 1222 (Fed. Cir. 1988). Applicant has not demonstrated that the commercially successful product described in the cited publications is the "invention disclosed and claim[ed] in patent." "Evidence as to commercial success is probative of non-obviousness

only if it is result of inventive features claimed, as opposed to other factors." Lamont v. Berguer, 7 U.S.P.Q.2d 1580 (Bd. Pat. App. & Inter. 1988). The evidence presented by applicant for a showing of commercial success fails to show that the commercial success alleged by applicant is a "result of inventive features claimed, as opposed to other factors."

> Prima facie case of nexus between merits of claimed invention and alleged commercial success is made by showing that product is commercially successful and is invention disclosed and claimed in subject application; this showiing, in civil litigation, shifts burdern of going forward with evidence to adversary, but such shift is inapplicable in ex parte proceedings in Patent and Trademark Office, since patent examiner has no available means for adducing evidence to show that commercial success was due to extraneous factors, and thus in such ex parte proceedings it is necessary for party to show that commercial success was due to merits of claimed invention.

Ex Parte Remark, 15 U.S.P.Q.2d 1498 (Bd. Pat. App. & Inter. 1990). Applicant has not shown that the product that is commercially successful is the "invention disclosed and claimed in subject application" and "that commercial success was due to merits of claimed invention" and therefore applicants showing of commercial success is deemed insufficient to overcome the rejections of the claims.

5. Claims 1-11, 13-15, 17-23, and 25-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,008,853 to Bly et al. ("Bly") in view of U.S. Patent No. 5,173,854 to Kaufman et al. ("Kaufman").

6. In the Remarks, Applicant argues, in substance, that [a] Bly neither disclosed nor suggested a system which permitted multiple remote users to concurrently view the same computer file and review edits as they were made; [b] the system of Bly allowed only a single user to access a given file at any particular point in time; [c] when a user of Bly's system accessed a file, all other users on the system were locked out of the file and were, by design, precluded from viewing the file, thus teaching away from the invention; [d] Kaufman did not teach the transmission of edit input data on a real-time basis; and [e] there is no suggestion to combine Bly and Kaufman to yield the claimed invention.

7. With respect to [a], Bly's system is an improvement on the conventional collaborative system of the WYSIWIS ("What You See Is What I See") variety. In the conventional system, "users see exactly the same image of information, i.e., all user's images are identical, and also users can see where users are cursively pointing to and changing information." col.1, lines 34-41. Therefore, contrary to Applicant's argument, Bly explicitly taught a system which permitted multiple

remote users to concurrently view the same computer file and review edits as they were made.

8. With respect to [b], Bly taught that a plurality of users could view and edit a particular entry of the shared structured data object, e.g., a file (col.9, lines 40-41). Therefore, contrary to Applicant's argument, the system of Bly allowed more than a single user to access a given file at any particular point in time.

9. With respect to [c], this argument is no more than a conclusory statement which is not based on any teaching of Bly. Further, the responses to points [a] and [b] show this statement to be false.

10. With respect to [d], Bly taught the transmission of edited information on a real-time basis. Kaufman taught that the transmission of edited information could take the form of sending only editing changes or input data. Taken together, Bly and Kaufman taught the transmission of edit input data on a real-time basis.

11. With respect to [e], the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as

a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, Bly taught the invention substantially as claimed, but did not teach that only editing changes were to be transmitted, and Kaufman taught, in the same environment of remote editing of files, that it was beneficial to transmit only editing changes (e.g., editing instructions) rather than entire changed files because to do so would be more economical, thereby providing the incentive to combine the teachings.

12. Applicant's arguments filed 5/2/94 have been fully considered but they are not deemed to be persuasive.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT

WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,206,934 to Naef, III

U.S. Pat. No. 5,280,583 to Nakayama et al.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Y. Wang whose telephone number is (703) 305-3838.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Peter Y. Wang

June 30, 1994

THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 2300